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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/759,997

01/16/2004

Mark T. Marshall

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MEDTRONIC, INC.
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EXAMINER

ALTER, ALYSSA M

ART UNIT

PAPER NUMBER

3762

MAIL DATE

DELIVERY MODE

02/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/759,997	Applicant(s) MARSHALL ET AL.	
	Examiner ALYSSA M. ALTER	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 8-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 8-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection by Halperin et al. (US 5,564,434 A) necessitated by amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3-6, 8-34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Halperin et al. (US 5,564,434 A). Halperin et al. discloses a lead body with a sensor module as seen in figures 2 and 3. "The pressure sensor module 20 is located just proximal to the distal tip of the assembly 26 and is mechanically and electrically connected to the coaxial, outer and inner, coiled wire lead conductors 14 and 16" (col. 7, lines 20-24). The two wire lead conductors, 14 and 16, are separated by an inner insulating sleeve 46 and encased by an outer insulating sleeve 46. Since coil 16 is disposed within coil 14, the examiner considers conductor 14 to be the coil conductor and coil 16 to be the cable conductor disposed within conductor 14. Also the electrically insulative layer between the two conductors is the insulating sleeve 22. Furthermore, since the insulative sleeve covers

the cable conductor (coil 16), the examiner considers it to be a coating over cable conductor.

In the alternative, although the examiner considers Halperin et al. to disclose an insulative coating above, it would have been obvious at the time the invention was made to substitute the insulative sleeve over the cable conductor with an insulative coating on the exterior in order to yield the predictable results of insulating the conductor and reducing the diameter of the lead.

Furthermore, Halperin et al. discloses the use of polyurethane insulation, which has a dielectric coefficient or dielectric constant less than 10. Since the coil 14 and the coil 16 are formed from two separate components, there is necessarily a gap between the two, since they are not unitary.

Halperin et al. discloses the claimed invention except for the specific ranges of the size of the coil, insulation and the gap dimensions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the size of the coil, insulation and the gap dimensions, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (see MPEP 2144.05). Furthermore, determining the most appropriate size by routine experimentation would be prima facie obvious to one having ordinary skill in the art.

Additionally, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the size and dimension of the lead components as taught by Halperin et al. with a specific range since it was known in the

art that modifications to the size and dimension of lead components to create a larger or more compact lead, the would modify the lead to meet specific patient needs.

As to claims 3, 8-14, 22-29, Halperin et al. discloses the claimed invention except for the preferred material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the the employed material as taught by Halperin et al. with the perferred material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416 (See MPEP 2144.07).

2. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Halperin et al. (US 5,564,434 A) in view of Cobian et al. (US 5,796,044). Halperin et al. discloses the claimed invention except for the insulative layer formed as a coating. Cobian et al. teaches that it is known to place a coating or layer of insulation on a conductor wire or coil as set forth in columns 3-4, lines 66-67 and lines 1-23, for the purpose of insulating a wire with a tight and intimate bond. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the sleeve as taught by Halperin et al. with the coating as taught by Cobian et al., since such a modification would enable an tight and intimate connection between the coil and the insulation.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALYSSA M. ALTER whose telephone number is (571)272-4939. The examiner can normally be reached on M-F 9am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alyssa M Alter
Examiner
Art Unit 3762

/George R Evanisko/
Primary Examiner, Art Unit 3762